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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,090	02/03/2004	Margaret H. Baron	HUIP-P02-060	4153

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HOWARD, ZACHARY C	
ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/772,090	**Applicant(s)** BARON ET AL.	
	Examiner ZACHARY C. HOWARD	**Art Unit** 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 April 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☒ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *43,57-60,62-66 and 68*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See box 3b above.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Elizabeth C. Kemmerer/
Primary Examiner, Art Unit 1646

Continuation of 3. NOTE:

3b. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because they raise the issue of new matter.

In Purdue Pharma L.P.v. Faulding Inc., 230 F.3d 1320, 1326, 56 USPQ2d 1481, 1486 (Fed Cir. 2000), the court noted that with respect to In re Ruschig 379 F.2d 990, 154 USPQ 118 (CCPA 1967) that "Ruschig makes clear that one cannot disclose a forest in the original application, and then later pick a tree out of the forest and say "here is my invention". In order to satisfy the written description requirement, the blaze marks directing the skilled artisan to that tree must be in the originally filed disclosure".

Proposed claim 43 is directed to a method of inhibiting abnormally enhanced vascular growth by administering an effective amount of a Sonic hedgehog blocking antibody. However, there are no "blaze marks" directing the skilled artisan to methods of use of this particular combination of vascular growth and hedgehog compound. Furthermore, claims 60 and 69 are directed to treatment of a solid tumor with a Sonic hedgehog blocking antibody, and there no "blaze marks" directing the skilled artisan to the particular combination of solid tumor and Sonic hedghog blocking antibody.

Instead, the specification teaches a "forest" of diseases from paragraphs 115-118 (published application), including blood abnormalities, abnormal blood vessel formation resulting from genetic diseases, chronic degenerative diseases, aging, trauma or infectious agents, excess hematopoiesis, solid tumors, hemangiomas in infancy, ocular neovascularization, bleeding disorders of the female reproductive tract and arthritis. Furthermore, the specification teaches a "forest" of hedgehog compounds in paragraph 95 (published application) including homologs of hedgehog compounds, recombinant hedgehog proteins, hedgehog encoding nucleic acids, antisense molecules, gene constructs for use in gene therapy including viral vectors known in the art, combinatorial mutants of hedgehog proteins as agonists or antagonists, and antibodies specific for hedgehog protein epitope. Furthermore, the specification teaches in the following sentence that these compounds in general "may be selected for modulating hematopoiesis and vascular growth according to the assays of the invention", which encompasses both inhibition and proliferation. Thus, there are no clear teachings directing the use of antibodies specific for the hedgehog protein in inhibition of abnormally enhanced vascular growth (as opposed to modulating vascular growth in general). Furthermore, there are no blaze marks directing the use of an antibody in treating solid tumors.

Furthermore, the specific antibody currently recited in the claims ("Sonic hedgehog blocking antibody") only appears in Example 4 (including Figure 11), where it is used to inhibit "Primitive Erythropoiesis in Cultured Whole Embryos using a Shh blocking antibody", which is not form of abnormally enhanced vascular growth as recited in the claims. There are no other teachings in the specification regarding "blocking" antibodies. Furthermore, there are no teachings regarding an "effective" amount of a Sonic hedgehog blocking antibody that is effective to inhibit abnormally enhanced vascular growth. Thus, there are no clear teachings directing use of "Sonic hedgheog blocking antibodies" in inhibition of abnormally enhanced vascular growth as opposed to use in inhibiting primitive erythopoiesis in cultured embroys. Furthermore, there are no blaze marks directing the use of an antibody in treating solid tumors.

In summary, there are no specific teachings directing the skilled artisan to the specifically recited combination in the proposed claims, namely use of an effective amount of a particular hedgehog compound (Sonic hedgehog blocking antibody) in the particular recited method (inhibiting abnormally enhanced vascular growth).